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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/540,209	04/04/2000	Gary L. Breton	2709.1001001	9843

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HAMILTON, BROOK, SMITH & REYNOLDS, P.C.
530 VIRGINIA ROAD
P.O. BOX 9133
CONCORD, MA 01742-9133

EXAMINER

SAKELARIS, SALLY A

ART UNIT PAPER NUMBER

1634

DATE MAILED: 11/15/2002

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/540,209

Applicant(s)

BRETON, GARY L.

Examiner

Sally A Sakelaris

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 14-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicants' election of Group I(Claims 1-13) and nucleotide sequence SEQ ID NO: 4084 in paper no. 10, filed 8/02/2002, is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Applicants' amendments to claims 1, 5, 9, and 10 are acknowledged and entered. Accordingly, claims 1-28 are currently pending, claims 1-13 are under examination, and claims 14-28 are withdrawn from further consideration as being drawn to non-elected inventions.

Specification

2. The information disclosure statement filed June 25, 2002 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein had to be obtained by the examiner and was considered. In the future, applicant is required to provide copies or indicate a prior application in which the references were submitted.

Furthermore, the specification is objected to because of the following:

The title of the invention is not descriptive. The elected claims are drawn to nucleic acids but the title is directed to nucleic acids and amino acids. A new title is required that is clearly indicative of the invention to which the elected claims are directed.

Appropriate correction is required.

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Priority

3. Acknowledgement of the provisional application drawn to this same subject matter has been made. The filing date of the instant claims is deemed to be the filing date of the provisional application 60/128,705 04/09/1999.

35 U.S.C. 101/112 Utility Rejections

4. 35 U.S.C. 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

Definitions: [from REVISED INTERIM UTILITY GUIDELINES TRAINING MATERIALS;
repeated from <http://www.uspto.gov/web/menu/utility.pdf>]

"Credible Utility" - Where an applicant has specifically asserted that an invention has a particular utility, that assertion cannot simply be dismissed by Office personnel as being "wrong". Rather, Office personnel must determine if the assertion of utility is credible (i.e., whether the assertion of utility is believable to a person of ordinary skill in the art based on the totality of evidence and reasoning provided). An assertion is credible unless (A) the logic underlying the assertion is seriously flawed, or (B) the facts upon which the assertion is based is inconsistent with the logic underlying the assertion. Credibility as used in this context refers to the reliability of the statement based on the logic and facts that are offered by the applicant to support the assertion of utility. A *credible* utility is assessed from the standpoint of whether a person of ordinary skill in the art would accept that the recited or disclosed invention is currently available for such use. For example, no perpetual motion machines would be considered to be currently available. However, nucleic acids could be used as probes, chromosome markers, or forensic or diagnostic markers. Therefore, the credibility of such an assertion would not be questioned, although such a use might fail the *specific* and *substantial* tests (see below).

"Specific Utility" - A utility that is *specific* to the subject matter claimed. This contrasts with a *general* utility that would be applicable to the broad class of the invention. For example, a claim to a polynucleotide whose use is disclosed simply as a "gene probe" or "chromosome marker" would not be considered to be *specific* in the absence of a disclosure of a specific DNA target. Similarly, a general statement of diagnostic utility, such as diagnosing an unspecified disease, would ordinarily be insufficient absent a disclosure of what condition can be diagnosed.

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"Substantial utility" - a utility that defines a "real world" use. Utilities that require or constitute carrying out further research to identify or reasonably confirm a "real world" context of use are not substantial utilities. For example, both a therapeutic method of treating a known or newly discovered disease and an assay method for identifying compounds that themselves have a "substantial utility" define a "real world" context of use. An assay that measures the presence of a material which has a stated correlation to a predisposition to the onset of a particular disease condition would also define a "real world" context of use in identifying potential candidates for preventive measures or further monitoring. On the other hand, the following are examples of situations that require or constitute carrying out further research to identify or reasonably confirm a "real world" context of use and, therefore, do not define "substantial utilities":

A. Basic research such as studying the properties of the claimed product itself or the mechanisms in which the material is involved.

B. A method of treating an unspecified disease or condition. (Note, this is in contrast to the general rule that treatments of specific diseases or conditions meet the criteria of 35 U.S.C. 101.)

C. A Method of assaying for or identifying a material that itself has no "specific and/or substantial utility".

D. A method of making a material that itself has no specific, substantial, and credible utility.

E. A claim to an intermediate product for use in making a final product that has no specific, substantial, and credible utility.

Note that "throw away" utilities do not meet the tests for a *specific* or *substantial* utility. For example, using transgenic mice as snake food is a utility that is neither specific (all mice could function as snake food) nor substantial (using a mouse costing tens of thousands of dollars to produce as snake food is not a "real world" context of use). Similarly, use of any protein as an animal food supplement or a shampoo ingredient are "throw away" utilities that would not pass muster as specific or substantial utilities under 35 U.S.C. ' 101. This analysis should, of course, be tempered by consideration of the context and nature of the invention. For example, if a transgenic mouse was generated with the specific provision of an enhanced nutrient profile, and disclosed for use as an animal food, then the test for specific and substantial *asserted* utility would be considered to be met.

"Well established utility" - a specific, substantial, and credible utility which is well known, immediately apparent, or implied by the specification's disclosure of the properties of a material, alone or taken with the knowledge of one skilled in the art. "Well established utility" does not encompass any "throw away" utility that one can dream up for an invention or a nonspecific utility that would apply to virtually every member of a general class of materials, such as proteins or DNA. If this is the case, any product or apparatus, including perpetual motion machines, would have a "well established utility" as landfill, an amusement device, a toy, or a paper weight; any carbon containing molecule would have a "well established utility" as a fuel since it can be

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burned; any protein would have well established utility as a protein supplement for animal food. This is not the intention of the statute.

See also the MPEP at 2107 - 2107.02.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-13 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility due to its not being supported by either specific, substantial or a well established utility.

The claimed nucleic acids, polynucleotides, vectors, host cells containing same, methods of expression of nucleic acids and as vaccine compositions are not supported by a specific asserted utility because the disclosed use of the nucleic acid is not specific and is generally applicable to any nucleic acid isolated from *B. fragilis*. For example, the specification states that the nucleic acids may be useful as probes, primers, antisense etc. (See pages 31-39). These are non-specific uses that are applicable to nucleic acids in general and not particular or specific to the nucleic acid being claimed.

Further, the claimed nucleic acid is not supported by a substantial utility because no substantial utility has been established for the claimed subject matter. For example, the specification states that the nucleic acids/polynucleotides can be utilized in capturing a ligand, etc. (page 31). However, further research is needed to capture the ligand, and to determine the utility of the ligand, if any. The need for such research clearly indicates that the nucleic acids and/or their function is not disclosed as to a currently available or substantial utility. A starting material that can only be used to produce a final product does not have substantial asserted utility in those instances where the final product is not supported by a specific and substantial utility. In this case none of the proteins that are to be produced as final products resulting from processes involving claimed nucleic acids have asserted or identified specific and substantial utilities. The research contemplated by applicants to characterize potential protein products, especially their

biological activities, does not constitute a specific and substantial utility. Identifying and studying the properties of a protein itself or the mechanisms in which the protein is involved does not define a "real world" context or use. Similarly, the other listed and asserted utilities as summarized above or in the instant specification are neither substantial nor specific due to being generic in nature and applicable to a myriad of such compounds. Note, because the claimed invention is not supported by a specific and substantial asserted utility for the reasons set forth above, credibility has not been assessed. Neither the specification as filed nor any art of record discloses or suggests any property or activity for the nucleic acid such that another non-asserted utility would be well established for the compounds.

5. Claims 1-13 are also rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, since the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility for the reasons set forth above, one skilled in the art would not know how to use the claimed invention.

Claims 11-13 are further not enabling for vaccines in the treatment or prevention of a *B. fragilis* infection. The following factors have been considered in formulating this rejection (*In re Wands*, 858F.2d 731, 8 USPQ2d 1400 (Fed. Cir. 1988): the breadth of the claims, the predictability or unpredictability of the art, the amount of direction or guidance presented, the presence or absence of working examples of the invention and the quantity of experimentation necessary.

Claims 11-13 are broadly drawn to any vaccine composition comprising SEQ ID NO:4084, its complement, or an RNA of either and a pharmaceutically acceptable carrier, an adjuvant, or additional ingredients. As discussed above, the specification does not clearly set

forth any of the "vaccine compositions," "pharmaceutically acceptable carriers", "adjuvants", or "additional ingredients" and therefore the claims include all types of the aforementioned components. The specification does not at all enable a vaccine composition comprising SEQ ID NO: 4048. The specification does not specify any examples of said vaccine's ability to prevent or treat a *B. fragilis* infection. The specification further excludes any teachings of the biochemical effect of the vaccine with SEQ ID NO: 4084 and the way in which it confers the putative, resulting, preventative, or treated phenotype. The specification does not provide adequate guidance as to how to use the "pharmaceutically acceptable carrier", an "adjuvant", or "additional ingredients" with the vaccine comprising a nucleic acid of SEQ ID NO: 4084 to treat or prevent or prevent *B. fragilis* infection. In the absence of guidance in the specification and the general view of unpredictability that exists in the art of gene therapy such random experimentation is considered to be undue. Moreover, the use of a composition comprising a gene or cDNA for treating a disease is highly unpredictable and the art of administering genes to cells in vivo to provide a new genetic activity or to perform gene therapy is not well developed. Therefore, the specification does not at all, enable how to use any vaccine composition comprising SEQ ID NO:4084.

6. Claims 9 and 10 are rejected, as discussed below, under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

A review of the language of the claims 9-10 indicates that they are drawn to a genus, i.e., any 8 nucleotides capable of hybridizing to a sequence set forth in SEQ ID NO:4084, a complement of SEQ ID NO: 4084, or an RNA of the same wherein U is substituted for T.

The search indicates that SEQ ID NO: 4084 is a novel and unobvious sequence. There is a single species explicitly disclosed(a molecule consisting of SEQ ID NO: 4084 that is within the scope of the claimed genus).

The disclosure of a single disclosed species may provide an adequate written description of a genus when the species disclosed is representative of the genus. The present claims encompass any sequence capable of hybridizing, full length genes, splice variants and cDNAs that are not further described. There is substantial variability among the species of DNAs encompassed within the scope of the claims because SEQ ID NO: 4084 is only a fragment of any full length gene or cDNA species. When reviewing a claim that encompasses a widely varying genus, the examiner must evaluate any necessary common attributes or features. In the case of a partial cDNA sequence that is claimed with open language (comprising), the genus of, e.g., "a nucleic acid comprising a sequence capable of hybridizing," encompasses a variety of subgenera with widely varying attributes. For example, a cDNA's principle attribute would include its coding region. A partial cDNA that did not include a disclosure of any open reading frame (ORF) of which it would be a part, would not be representative of the genus of cDNAs because no information regarding the coding capacity of any cDNA molecule would be disclosed. Further, defining "the" cDNA in functional terms would not suffice in the absence of a disclosure of structural features or elements of a cDNA that would encode a protein having a stated function.

A description of a genus of cDNAs may be achieved by means of a recitation of a representative number of cDNAs, defined by nucleotide sequence, falling within the scope of the genus or of a recitation of structural features common to the members of the genus, which features constitute a substantial portion of the genus. Regents of the University of California v. Eli Lilly & Co., 119 F3d 1559, 1569, 43 USPQ2d 1398, 1406 (Fed. Cir. 1997).

Here, the specification discloses only a single common structural feature shared by members of the claimed genus i.e., a sequence capable of hybridizing to SEQ ID NO:4084.

Since the claimed genus encompasses genes yet to be discovered, splice variants, etc., the disclosed structural feature does not "constitute a substantial portion" of the claimed genus. Therefore, the disclosure of SEQ ID NO:4084 does not provide an adequate description of the claimed genus.

Weighing all factors, 1) partial structure of the DNAs that comprise SEQ ID NO:4084, 2) partial structure of DNAs that are capable of hybridizing to SEQ ID NO:4084, 3) the breadth of the claim as reading on genes yet to be discovered in addition to numerous splice variants and cDNAs, 4) the lack of correlation between the structure and the function of the genes and/or fusion constructs; in view of the level of knowledge and skill in the art, one skilled in the art would not recognize from the disclosure that the applicant was in possession of the genus of DNAs which comprise a sequence capable of hybridizing under stringent conditions to SEQ ID NO:4084 and therefore the written description requirement has not been satisfied for the claims as they are broadly written. Applicants attention is drawn to the Guidelines for the Examination of Patent Applications under 35 U.S.C. 112, ¶ 1 "Written Description" Requirement, Federal Register, Vol. 66, No.4, pages 1099-1111, Friday January 5, 2001.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

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(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

7. Claims 9 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Ratti et al.(US 6,110,705).

Ratti et al. teach a nucleic acid comprising a nucleotide sequence of at least eight nucleotides in length, wherein the sequence is hybridizable to a nucleic acid having a nucleotide sequence of SEQ ID NO: 4084.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Sally Sakelaris whose telephone number is (703) 306-0284. The examiner can normally be reached on Monday-Thursday from 7:00AM-5:30PM.

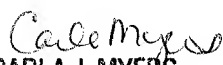
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W.Gary Jones, can be reached on (703)308-1152. The fax number for the Technology Center is (703)305-3014 or (703)305-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to Chantae Dessau whose telephone number is (703)605-1237.

Sally Sakelaris



11/13/02


CARLA J. MYERS
PRIMARY EXAMINER